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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/905,574

07/12/2001

Paul G. Glucina

HR1.P03

4225

7590

07/11/2007

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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT

PAPER NUMBER

1661

MAIL DATE

DELIVERY MODE

07/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/905,574	Applicant(s) GLUCINA ET AL.	
	Examiner S. B. McCormick-Ewoldt	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

In view of the reversal of the Board's decision filed on March 27, 2007, PROSECUTION IS HEREBY REOPENED. New set of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as the claimed plant as described and illustrated does not patentably distinguish over the plant forming the basis of United States Plant Patent Number 10,833. Applicant bears the burden of clearly and precisely describing the characteristics which define and distinguish the new variety (In re Greer 179 USPQ 301).

The application is not patentably distinct from the cited patent because of the instant specification's incomplete botanical listing of characteristics for the claimed plant. As a result, the prior art plant cannot be distinguish from the claimed plant. Both the prior art and the instant plant is a white, clingstone peach. Both the prior art and the instant plant have flesh color that is

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white, the fruit skin thickness is medium and the fruit skin color is overspread with light red. Both the prior art and the instant plant have medium flowers that are pink-colored. Applicant is advised that once the specification contains as full and complete a disclosure as possible of the plant, it may be sufficient to obviate this rejection.

Any minor differences between the instant plant and the prior art appear to be environmental and it is suggested to Applicant to grow plants side by side for an adequate comparison.

The claimed white, clingstone peach meet the limitations of claim 1 and thus anticipates the claimed invention because of an incomplete botanical description.

Claim 1 is rejected under 35 U.S.C. 102(b) as the claimed plant as described and illustrated does not patentably distinguish over the plant forming the basis of United States Plant Patent Number 10,911. Applicant bears the burden of clearly and precisely describing the characteristics which define and distinguish the new variety (In re Greer 179 USPQ 301).

The application is not patentably distinct from the cited patent because of the instant specification's incomplete botanical listing of characteristics for the claimed plant. As a result, the prior art plant cannot be distinguish from the claimed plant. Both the prior art and the instant plant is a white, clingstone peach. Both the prior art and the instant plant have flesh color that is white and the fruit skin thickness is medium. Both the prior art and the instant plant have medium flowers and are pink-colored. Both of the prior art and the instant plant is a large-sized tree. Applicant is advised that once the specification contains as full and complete a disclosure as possible of the plant, it may be sufficient to obviate this rejection.

Any minor differences between the instant plant and the prior art appear to be environmental and it is suggested to Applicant to grow plants side by side for an adequate comparison.

The claimed white, clingstone peach meet the limitations of claim 1 and thus anticipates the claimed invention because of an incomplete botanical description.

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Claim 1 is rejected under 35 U.S.C. 102(b) as the claimed plant as described and illustrated does not patentably distinguish over the plant forming the basis of United States Plant Patent Number 11,199. Applicant bears the burden of clearly and precisely describing the characteristics which define and distinguish the new variety (In re Greer 179 USPQ 301).

The application is not patentably distinct from the cited patent because of the instant specification's incomplete botanical listing of characteristics for the claimed plant. As a result, the prior art plant cannot be distinguish from the claimed plant. Both the prior art and the instant plant is a white, clingstone peach. Both the prior art and the instant plant have flesh color that is white, fruit skin color that is red and the fruit skin thickness is medium. Both the prior art and the instant plant have flowers that are pink-colored. Both of the prior art and the instant plant is a large-sized tree. Applicant is advised that once the specification contains as full and complete a disclosure as possible of the plant, it may be sufficient to obviate this rejection.

Any minor differences between the instant plant and the prior art appear to be environmental and it is suggested to Applicant to grow plants side by side for an adequate comparison.

The claimed white, clingstone peach meet the limitations of claim 1 and thus anticipates the claimed invention because of an incomplete botanical description.

Claim 1 is rejected under 35 U.S.C. 102(b) as the claimed plant as described and illustrated does not patentably distinguish over the plant forming the basis of United States Plant Patent Number 11,205. Applicant bears the burden of clearly and precisely describing the characteristics which define and distinguish the new variety (In re Greer 179 USPQ 301).

The application is not patentably distinct from the cited patent because of the instant specification's incomplete botanical listing of characteristics for the claimed plant. As a result, the prior art plant cannot be distinguish from the claimed plant. Both the prior art and the instant plant is a white, clingstone peach. Both the prior art and the instant plant have flesh color that is white, fruit skin color that is red and the fruit skin thickness is medium. Both the prior art and the instant plant have an average fruit weight of 170 grams. Applicant is advised that once the

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specification contains as full and complete a disclosure as possible of the plant, it may be sufficient to obviate this rejection.

Any minor differences between the instant plant and the prior art appear to be environmental and it is suggested to Applicant to grow plants side by side for an adequate comparison.

The claimed white, clingstone peach meet the limitations of claim 1 and thus anticipates the claimed invention because of an incomplete botanical description.

Claim 1 is rejected under 35 U.S.C. 102(b) as the claimed plant as described and illustrated does not patentably distinguish over the plant forming the basis of United States Plant Patent Number 11,553. Applicant bears the burden of clearly and precisely describing the characteristics which define and distinguish the new variety (In re Greer 179 USPQ 301).

The application is not patentably distinct from the cited patent because of the instant specification's incomplete botanical listing of characteristics for the claimed plant. As a result, the prior art plant cannot be distinguish from the claimed plant. Both the prior art and the instant plant is a white, clingstone peach. Both the prior art and the instant plant have flesh color that is white, fruit skin color that is red and the fruit skin thickness is medium. Both the prior art and the instant plant have an average fruit weight of 170 grams. Both the prior art and the instant plant have pink-colored flowers. Applicant is advised that once the specification contains as full and complete a disclosure as possible of the plant, it may be sufficient to obviate this rejection.

Any minor differences between the instant plant and the prior art appear to be environmental and it is suggested to Applicant to grow plants side by side for an adequate comparison.

The claimed white, clingstone peach meet the limitations of claim 1 and thus anticipates the claimed invention because of an incomplete botanical description.

#### Summary

The claim is not allowed.

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Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

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